

REMARKS

Regarding the traversal, Applicants respectfully submit that the Examiner errs in focusing on an alleged technical feature of Group II being “an apparatus for the labeling biomolecule.” Claim 8 expressly relates to “an apparatus *for performing* the process according to claim 1.” Applicants draw the Examiner’s attention to MPEP § 1850(III)(A):

“The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

* * *

(B) In addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process * * *.”

That same section states later on that:

“[T]he expression ‘specially designed’ does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.”

The Examiner has not shown that the apparatus of Subramanian, US 5,244,816, is capable of performing the process according to claim 1 and, therefore, that the apparatus of claim 8 is not specially designed for carrying out the process of claim 1.

With respect to the species elections, the Examiner has required elections based on restriction practice applicable to U.S. national applications, rather than to national stage applications of international applications. In this regard, Applicants draw the Examiner's attention to MPEP § 1893.03(d):

“Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371.”

The Examiner has not applied the unity of invention concepts to the two required species elections and, therefore, this portion of the restriction requirement is clearly improper.

Moreover, the Examiner has justified the species election with nothing more than some broad, sweeping remarks concerning alleged “mutually exclusive characteristics” of the different species of biomolecules. It remains quite unclear what these characteristics are and just what their impact on the claimed process might be. In this regard, Applicants respectfully submit that the similarities between the different species of biomolecules, which enable them to be labeled by the claimed method, clearly outweigh any perceived differences. Indeed, Applicants bring to the Examiner's attention the fact that the European Patent Office has granted the parallel European application without any restriction.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the restriction requirement altogether or at least consider and examine all of the species together.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By /Kurt G. Briscoe/

Kurt G. Briscoe

Attorney for Applicant(s)

Reg. No. 33,141

875 Third Avenue - 18th Floor

New York, New York 10022

Phone: (212) 808-0700

Fax: (212) 808-0844